

Claims 36-38 are rejected under 35 U.S.C. 112, second paragraph. This rejection is respectfully traversed.

It is submitted that claim 5 does not require these elements be alternatives to one another, since it recites that "R⁴ and R⁵ may be the same or different." It is also submitted that claims 36-38 do not require each of these elements. Instead, each of these claims merely state possible choices for each of the elements. Accordingly, it is submitted that these claims are clear as written.

Claims 4, 10, 31 and 33 are objected to. It is submitted that this objection is moot because the present response cancels claims 31 and 33 without prejudice.

Claims 1-29, 31-33 and 35-40 are rejected under 35 U.S.C. § 103 (a) as allegedly being obvious based on WO 93/13179 (WO '179). This rejection is respectfully traversed with respect to pending claims 1-29 and 35-40.

The present Office Action states that the reference is "applied for the same reasons as discussed in paragraph 8 of the Office action mailed July 6, 2001, and in the final Office action mailed May 26, 2002" and that the "claims are additionally rejected for the reasons discussed above in paragraph 3." Page 4 of the Action, paragraph 7. These reasons are addressed herein below.

Office Action of July 6, 2001, paragraph 8

WO '179 is cited for allegedly disclosing all the claimed limitations "except the method of WO '179 discloses applying its composition as a single layer comprising both components (A) and (B) and then reacting the two components by a condensation curing reaction, instead of Applicant's claimed method of first applying film-forming polymer component (A) as a first layer followed by applying fouling-inhibiting material component (B) as a second layer and then reacting the components/layers by a condensation curing reaction." Page 5, paragraph 8, of the subject Action.

It is respectfully submitted that the claimed method cannot be obvious based on a reference which uses a completely different method. To establish a prima facie case of obviousness, the reference must teach or suggest the claimed limitations. MPEP 2142. If WO '179 teaches or suggests a method other than that claimed, it teaches or suggest something other than the claimed invention and, thus, it would not lead a skilled artisan to the claimed invention.

Final Office Action of May 26, 2002

Preliminarily, it is submitted that the Final Office Action of March, not May 26, 2002 is discussed herein, since the undersigned's file for the present application includes a Final Office Action from March, not May, 2002, converse to the statement in the present Office Action. Kindly advise the undersigned if this is incorrect.

In the Final Office Action, the rejection is maintained based on the assertion that "the instant claims are broad enough to read on applying two layers of WO '179's coating composition, one applied on top of the other, such as two overlapping/overlying brush, roller, or spray painting strokes." Page 3, paragraph 4, of the subject Action.

This basis for rejection is addressed below, together with the basis given in the present Action.

Office Action of January 21, 2003

The present Action sets forth additional reasons in paragraph 3 for maintaining the rejection. It contends that "the functional groups on polymer (A) of WO '179 do provide latent reactivity," that the present claims require that the functional groups of component (A) have latent reactivity and that "in the method of WO '179 "the functional groups on component A exist only until reaction with component B (at which point they are reacted and become part of the condensation product), therefore they will necessarily have latent reactivity during their existence as unreacted functional groups." Page 3, paragraph 3, of the subject Action.

The point necessarily missing from these arguments is that the claimed method requires a step of forming a coating on a substrate and that the coating comprises film-forming polymer (A) carrying unreacted curable silicon-containing functional groups providing latent reactivity. Specifically, it requires "forming on the substrate, before exposure to the environment, a coating comprising a film-forming polymer (A) carrying unreacted curable silicon-containing functional groups providing latent reactivity." Emphasis added.

WO '179 simply does not teach or suggest forming a coating, as opposed to a wet coating formulation/composition, of A and then, thereafter applying a layer of B and bonding layer B to coating A by a condensation curing reaction, as in the present claims. Accordingly, WO '179 cannot make the claimed invention obvious, even if the present claims are broad enough to read on a wet-on-wet process, "such as two overlapping/overlying brush, roller, or spray painting strokes" (quoting Page 3, paragraph 4, of the Final Office Action).

Respectfully submitted,



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